

Atty. D.t. No.: P63132 US0  
Serial No.: 09/171,607

Applicants wish to thank Examiner Amy DeCloux for bringing this matter to their attention and for providing the instant Office Action as an opportunity to resolve the matter.

*Request to Grant §119 Priority*

In the prior Office Action mailed October 9, 2001 (the "prior Action"), the priority claim under 35 USC 119 to DE19615710.2, filed April 24, 1996, was "not granted" (prior Action page 2). The grant was denied because one of the presently named inventors (Ludger Ständker) is not a named inventor on the face of the priority document, and MPEP 201.13 C was cited in support of the denial.

The refusal to grant the §119 priority claim was incorrect. In fact, MPEP 201.13C requires the contrary result; i.e., under MPEP 201.13C, the instant application is entitled to the grant of foreign (§119) priority made in the inventorship declaration.

MPEP 201.13C (*emphasis added*) reads:

*C. Identity of Inventors*

The inventors of the U.S. nonprovisional application and of the foreign application must be the same . . . for a right of priority . . . . However, the application in the foreign country may have been *filed by the assignee*, . . . which is permitted in some foreign countries, rather than by the inventor himself . . . *An indication of the identity of inventors made in the oath or declaration accompanying the U.S. nonprovisional application by identifying the foreign application and stating that the foreign application had been filed by the assignee of the inventor . . . is acceptable.*

In the present case, the foreign priority application was, indeed, filed by the assignee of the inventor, Wolf-Georg Forssmann, identified as the "Applicant" on the face of the priority application

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(and, also, a presently named inventor). Additionally, the inventorship declaration of record identifies the foreign application filed by the inventor's assignee.

Accordingly, granting of the §119 priority claim in the inventorship declaration to DE19615710.2 is in order, MPEP 201.13C, and the Examiner is requested to indicate on the next Office Action that the priority claim is granted.

***Resubmitting Form PTO 1449***

Form PTO 1449 resubmitted, herewith, was submitted with an information disclosure statement (IDS), listing references for the Examiner's consideration, copies of which were provided. The listed references were all cited in the international search report on the parent international application, which international search report was included with the IDS. The international search report assigned each of the cited references an "X", "Y", or "A" indication.

The Form PTO 1449 was returned with a line drawn through the listing of DE3633797A1, indicating the Examiner did not consider the reference. According to the Office Action (mailed March 14, 2000) accompanying the returned Form PTO 1449, the reference listing at issue was not considered because an English language translation was not provided.

The refusal to consider references was improper and contrary to PTO rules. As explained in MPEP 609, III, A(3) (*emphasis added*):

Where the information listed is *not in the English language*, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, *the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the*

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degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.

As indicated, above, the corresponding international search report, provided with the IDS, cited the reference at issue with an "X", "Y", or "A" indication. Accordingly, the requirements for having the Examiner consider the reference at issue, which "is not in the English language," is "satisfied." MPEP 609, III, A(3).

In view of the foregoing, the Examiner is asked to mark the resubmitted Form PTO 1449 to indicate that the reference at issue was considered, as required, and return the appropriately marked Form PTO 1449 with the next Office Action.

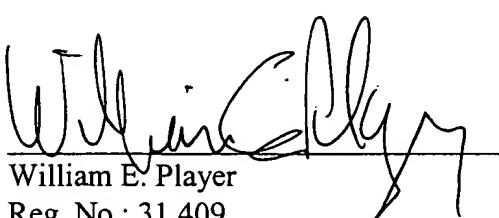
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Favorable action is requested.

Respectfully submitted,

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